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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,925	03/06/2006	Paul David Howlett	257.043	7140

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EXAMINER	
COLLINS, GIOVANNA M	
ART UNIT	PAPER NUMBER
3672	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/537,925	HOWLETT, PAUL DAVID	
	Examiner	Art Unit	
	Giovanna M. Collins	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 June 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5 and 8-23* is/are rejected.

7)☒ Claim(s) *6 and 7* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 June 2005* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/15/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

(a) TITLE OF THE INVENTION.
(b) CROSS-REFERENCE TO RELATED APPLICATIONS.
(c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
(d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
(e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
(f) BACKGROUND OF THE INVENTION.
    (1) Field of the Invention.
    (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
(g) BRIEF SUMMARY OF THE INVENTION.
(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
(i) DETAILED DESCRIPTION OF THE INVENTION.
(j) CLAIM OR CLAIMS (commencing on a separate sheet).
(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
(l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

1. The disclosure is objected to because of the following informalities: The section headings have been omitted.

Appropriate correction is required.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 26. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4 and 14-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Lynde 6607031 .

Referring to claim 1, Lynde discloses (Figs. 3-4) a downhole tool for use in a cased or lined well bore, the tool comprising a body (66) connectable in a work string, a fluid flow path (72) through the tool body and a barrier (74) located at an outer surface of the tool, wherein the barrier is actuable to control fluid flow passing the tool and selectively divert fluid flow through the flow path (col. 4, lines 20-32).

Referring to claim 2, Lynde discloses the barrier comprises a resilient member (74, col. 5, lines 11-13) which when acted upon by actuating means deforms to extend the member towards a wall of the well bore (see fig. 4a).

Referring to claims 3-4, Lynde discloses the barrier (74) is a wiper that provides a seal so fluid does not pass the seal (col. 4, lines 30-32) and the wiper will clean the casing as the tool is moved upwardly in the wellbore.

Referring to claims 14-15 and 19, Lynde discloses a downhole tool for collecting loose debris particles within a well bore, the tool comprising a body (66) connectable in a work string, a fluid flow path (72) through the tool body including a screen (80) sized to prevent particles of a particular size from passing through and a barrier (74) located at an outer surface of the tool, the barrier comprising a resilient member (col. 5, lines 11-13), wherein the barrier deforms on actuation to control fluid flow passing the tool and selectively divert fluid flow through the flow path (col. 4, lines 20-32) and having a surface engageable with the well bore to provide a seal (see fig. 4a).

Referring to claim 16, Lynde discloses a trap (see fig. 1e, at 28, same trap shown in fig. 5e) for collecting debris.

Referring to claim 17-18, Lynde discloses the resilient member (74) is rubber ball or an inflatable bladder (col. 5, lines 11-13).

Referring to claims 20-23, Lynde discloses a method of controlling fluid flow in a well bore, comprising the steps: running (see fig. 3a) a tool (at 66) having an actuable barrier (74) on a work string (tubing above element 66) downhole; creating relative movement between the fluid in the well bore and the tool (having fluid flow past the tool); actuating the barrier (74, col. 4, lines 20-32) to control fluid flow passing the tool by varying the cross sectional area of the annulus between the tool and the wall of the well bore (see fig. 4a, at 74), including the step of selectively diverting fluid flow through a flow path in the tool (see fig. 4a, at 96), including the step of actuating the barrier until the barrier sealingly engages the wall of the well bore and thus substantially restricts fluid flow passing the tool (fig. 4a and col. 4, lines 27-29 and includes the step of .filtering the fluid flow (at 80) through the flow path in the tool.

5. Claims 1-2 ,10-11 and 13, are rejected under 35 U.S.C. 102(b) as being anticipated by Hill et al. 6382319 .

Referring to claim 1, Hill discloses (fig. 5-8) a downhole tool for use in a cased or lined well bore, the tool comprising a body (46) connectable in a work string, a fluid flow path (at 104) through the tool body and a barrier (22) located at an outer surface of the

tool, wherein the barrier is actuable to control fluid flow passing the tool and selectively divert fluid flow through the flow path (see fig. 7, bypass at 56).

Referring to claim 2, Hill discloses the barrier comprises a resilient member (22) which when acted upon by actuating means deforms to extend the member towards a wall of the well bore (see fig. 7).

Referring to claims 10-11, and 13, Hill discloses the a plurality of fluid flow paths (at 50, 66 and 82), one flow path includes a filter (see fig. 13, flow path down center continues on pass filter 16, at bottom of the tool) and one flow path (66) has an inlet (at 56) and an outlet (see fig. 6 and 8 ,at 29) on either side of the barrier.

6. Claims 1-2 ,5,8-10, and 12, are rejected under 35 U.S.C. 102(b) as being anticipated by Williams 2638988 .

Referring to claim 1, Williams discloses (fig. 1) a downhole tool for use in a cased or lined well bore, the tool comprising a body (10) connectable in a work string, a fluid flow path (38) through the tool body and a barrier (25) located at an outer surface of the tool, wherein the barrier is actuable to control fluid flow passing the tool and selectively divert fluid flow through the flow path (see fig. 3,bypass at 38).

Referring to claim 2, Williams discloses the barrier comprises a resilient member (25) which when acted upon by actuating means deforms to extend the member towards a wall of the well bore (see fig. 3).

Referring to claim 5, 8, Williams discloses the actuating means includes a ball valve (51) that is an hydraulic actuator, (hydraulic pressure on the ball actuates the sealing member 25).

Referring to claim 9, Williams disclose the barrier is actuable through a drop ball (52) released at the surface and carried through the work string and selectively actuable as the ball is deformable (all material can be deformed when put under enough force).

Referring to claims 10 and 12, Williams discloses a plurality of flow paths (see fig. 3, at 30,38) and one fluid path (30) forms a hydraulic line for the actuation of a feature of the downhole tool (hydraulic fluid on the ball causes the sealing member 25 to actuate).

Allowable Subject Matter

7. Claims 6-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna M. Collins whose telephone number is 571-272-7027. The examiner can normally be reached on 6:30-3 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

gmc

Giovanna M. Collins
Patent Examiner
Technology Center 3670